

REMARKS

Reconsideration of the Office action dated October 22, 2001, is requested in view of the foregoing amendment and the following remarks. Prior to entry of this amendment, claims 1-17 were pending, with claims 1-17 rejected under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 102(b).

35 U.S.C. § 112, second paragraph, requires that the claims particularly point out and distinctly claim the subject matter which applicants regard as their invention. Acceptability of claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. MPEP 2173.05(b). In this regard, the acceptance of claim language depends on whether the claim language is clear enough to inform the public of the boundaries of what constitutes infringement of the patent. As discussed below, the claim language, read in light of the specification and drawings, provides ample notice to the public of what the applicants regard as their invention.

Claims 1, 2 and 4-17 were rejected under 35 U.S.C. § 112, second paragraph, for setting forth indefinite claim language. The Examiner states that it is not clear what structure or feature is encompassed by “customer-defined identifying material.” Applicants note that “customer-defined identifying material” is described in the specification on page 9, lines 19-21, and page 10, lines 1-15. Specifically, on page 10, lines 1-2, the specification states that “printed material 38 further may include identifying material 42, preferably a customer-defined toy name 44 and a customer-defined intended recipient 46.” Thus, the claims, when read in light of the specification, clearly apprise those skilled in the art of what

is intended by “customer-defined identifying material.” Therefore, applicants respectfully request the withdrawal of the rejection of claims 1, 2 and 4-17 under 35 U.S.C. § 112.

Claims 2 and 4-17 were further rejected under 35 U.S.C. § 112, second paragraph, as being indefinite due to the recitation of a “personalized toy.” The Examiner states that it is unclear what would constitute a personalized toy. Applicants respectfully disagree and note that one possessing an ordinary level of skill in the art would understand the meaning of a “personalized toy” to be a toy possessing some degree of personalization. Additionally, it further should be noted, as described in the Background and Summary of the Invention (page 1, line 15) that “patents were discovered disclosing what could be described as personalized toys, ...”. Thus, in light of the specification and the cited references, the language, “personalized toy,” reasonably apprises those of skill in the art, both of the utilization and the scope of the invention, and is as precise as the subject matter permits. *Shatterproof Glass Corp. v. Libbey Owens Ford Co.* 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985). Therefore, applicants respectfully request the withdrawal of the rejection of claims 2, and 4-17 under 35 U.S.C. § 112.

Claims 5 and 12 were further rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting a “customer-defined toy name.” The Examiner states that it is unclear what structure or feature is being encompassed by the recitation. Applicants direct the Examiner’s attention to the specification which discloses that a “customer-defined toy name 44” (page 10, line 2) may be included on identifying material 42. The drawings further illustrate what is intended by the customer-defined toy name at 44 in Fig. 3. Specifically, the “customer-defined toy name” is a name for the toy selected by

the customer. For example, the customer-defined toy name “Carla” is indicated at 44 in Fig. 3. Thus, the recitation of a “customer-defined toy name” particularly points out and distinctly claims the subject matter, which the applicants regard as their invention. Therefore, applicants respectfully request the withdrawal of the rejection of claims 5 and 12 under 35 U.S.C. § 112.

Similarly, claims 6 and 13 were rejected as being indefinite for reciting “customer-defined intended recipient.” A customer-defined intended recipient is shown at 46 in the drawings. Specifically, the customer-defined intended recipient is the intended recipient of the toy as selected by the user. For example, in Fig. 3 at 46, the customer-defined intended recipient is “Jennifer.” One of ordinary skill in the art would understand what is claimed, in light of the specification. Therefore, applicants respectfully request the withdrawal of the rejection of claims 6 and 13 under 35 U.S.C. § 112.

Claim 14 was rejected as being indefinite for “a story relating to the personalized toy.” The Examiner states that it is unclear what would constitute a story relating to the personalized toy. Applicants respectfully disagree and direct the Examiner’s attention to page 9, lines 19-21 which states “Printed material 38 preferably includes textual information such as a story 40...” Additionally, reference indicator 40 in Fig. 3 further illustrates what is intended by a story. Applicants further direct the Examiner to Fig. 11 for an example of a “story relating to a personalized toy.” Thus, in light of the description and the figures, applicants believe that a hypothetical person possessing an ordinary level of skill in the art would understand what is intended by “a story relating to the personalized toy.”

Therefore, applicants respectfully request the withdrawal of the rejection of claim 14 under 35 U.S.C. § 112.

Finally, claim 15 was rejected for “tabs configured to support the identifying material on the inside of the flap.” The Examiner states that it is not clear as to what configuration the tabs must have in order to meet the claim. Applicants direct the Examiner’s attention to lines 7-15 on page 10. Specifically, package 34 includes “a front flap 50 with tabs 52 formed on the inside of flap 50.” Printed material 38 is connected to the inside of flap 50 “by inserting edges of printed material 38 under tabs 52.” Tabs 52 are further illustrated in Fig. 3. Thus, claim 15, when read in light of the specification, sets forth the subject matter of the invention and defines the subject matter with a reasonable degree of particularity and distinctiveness. Therefore, applicants respectfully request the withdrawal of the rejection of claim 15 under 35 U.S.C. § 112.

Claims 1-17 were further rejected under 35 U.S.C. § 102(b) as being anticipated by Zerbo (U.S. Patent No. 3,144,932). Applicants agree with the Examiner that Zerbo discloses a container 10 having a cover 11 to display flowers F. However, applicants note that Zerbo does not disclose a package for a “personalized toy” as recited in claims 1-17. Zerbo only discloses a container intended for generic, non-personalized flowers.

Similarly, Zerbo does not disclose “customer-defined identifying material” as recited in the claims in the present application. In contrast, Zerbo discloses a pictorial illustration 17 that provides the “purchaser a clear idea of what can be done with the contents of the specific package under consideration.” (column 3, lines 1-3). The pictorial

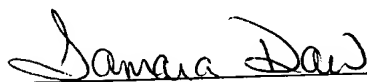
illustration is a generic illustration and is not personalized to the customer. Therefore, claims 1-17 should be allowed under 35 U.S.C. 102(b).

As required by 37 C.F.R. § 1.121, applicants have provided a separate marked-up version of the amended specification.

The above amendments and remarks are believed to fully address the Examiner's rejections, and place the application in condition for allowance. A prompt indication of the same respectfully is requested. The Examiner is encouraged to telephone the undersigned if any issues remain that may be resolved by a telephonic interview.

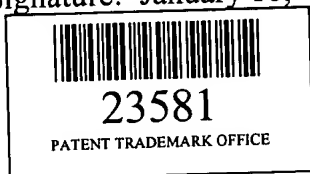
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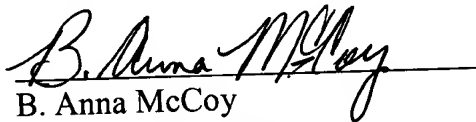


Tamara Daw

Date of Signature: January 18, 2002



Respectfully submitted,
KOLISCH, HARTWELL, DICKINSON,
McCORMACK & HEUSER


B. Anna McCoy

Customer No. 23581

Registration No. 46,077

of Attorneys for Applicants

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

The paragraph beginning at line 4 of page 1 has been amended as follows:

This application is a division [continuation] of and claims priority to U.S. Patent Application Serial No. 09/183,323 filed October 30, 1998 and issued on March 27, 2001 as U.S. Patent No. 6,206,750, of Jill E. Barad, Jeanette Corcuera, Greg Vineyard, Darian Pasterski, Palos Verdes, Joe Scully, John Watson, Roy Kaneshiro, Brian Channell, Jean Chu, Nancie Martin, Simon Cheung Shu Keun, and Li Tak Chee for a PERSONALIZED TOY AND METHOD FOR MANUFACTURING AND DELIVERING THE SAME, the disclosure of which is hereby incorporated by reference.